

REMARKS

Claims 1-14 are pending in the application.

Claims 1-14 have been rejected.

Claim 13 has been canceled, without prejudice.

New Claims 15-18 have been added.

No Claims have been amended.

I. OBJECTIONS TO THE SPECIFICATION AND DRAWINGS

The disclosure has been objected to because the detailed specification refers to reference numeral 208 and Figure 2 identifies the element 208 using the reference numeral 210. Applicant shall amend Figure 2 by replacing reference numeral 210 with reference numeral 208. As this is simply an inadvertent error on the part of the Applicant, Applicant respectfully requests that the Applicant be allowed to submit a new formal drawing (figure 2) including such correction, upon a notice of allowance and issue fee due transmittal issued by the Office.

The disclosure has also been objected to because Applicant's use of "text to speech" is unclear, and the Examiner suggests using "text-to-speech". This objection is respectfully traversed. This term is clear, as evidenced by the Examiner's understanding of the term, as well as by the common use of this term in other issued US patents - see, US Patent No. 5,774,854 (as cited in the Office Action) (using the term "text to speech" throughout the specification and claims). Accordingly, Applicant respectfully requests withdrawal of this objection.

II. REJECTION UNDER 35 U.S.C. § 102

Claim 6 was rejected under 35 U.S.C. § 102(b) as being anticipated by Sharman (US Patent No. 5,774,854. The rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Office Action argues, without any specific reference to passages in the cited reference, that Sharman discloses each and every element of Applicant's invention, as claimed in Claim 6. Applicant respectfully submits that the Office Action mischaracterizes the disclosure of Sharman. Specifically, Sharman discloses that words are broken down into their constituent syllables, and the syllables are then broken down into constituents phonemes, with the output being a sequence of phonemes. Sharman, Col. 5, lines 18-42. Thus, Sharman operates at the syllable level with phonemes (and diphones). In contrast, Applicant's invention (in claim 6) parses the text file into textual units - a textual unit being either a word, prefix, or suffix. Upon parsing, if the textual unit corresponds to a textual unit in a vocabulary of textual units, then the textual unit is added to a list. Therefore, Sharman fails to disclose parsing the text into textual units where each parsed textual unit is a word, prefix or suffix, such that if such

textual unit corresponds to a stored textual unit, the stored textual unit is added to a list.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claim 6.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 7-8 were rejected under 35 U.S.C. § 103 as being unpatentable over Sharman (US Patent No. 5,774,854) in view of well known prior art (MPEP 2144.03). Claims 1-5 and 9-14 were rejected under 35 U.S.C. § 103 as being unpatentable over Sharman (US Patent No. 5,774,854) in view of Busardo (US Patent No. 6,148,285). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more

the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to Claims 7-8 (which depend from Claim 6), the Office Action argues that “Sharman discloses everything claimed, as applied above (see claim 6)” and that “it was well known in the art to mark a text unit for further processing.” See, Office Action. page 3.

As clearly set forth above in Applicant's remarks regarding Claim 6, Sharman does not disclose everything claimed in Claim 6. To reiterate, Sharman fails to disclose parsing the text into textual units where each parsed textual unit is a word, prefix or suffix, such that if such textual unit corresponds to a stored textual unit, the stored textual unit is added to a list.

Applicant respectfully traverses the Office Action official notice that it is well known in the art to mark a text unit for further processing. Applicant's textual units are prefixes, suffixes and words in the art of text to speech processing, and it is unclear from the Office Action what is meant by the Office Action's "official notice" regarding the terms "mark", "text units" and "further processing" – as those terms are used by the Office Action in an abstract sense. Moreover, Applicant's Claims include the feature that "if said one of said parsed textual units does not correspond to one of said stored textual units" then the textual unit is marked (Claims 7-8). The Office Action fails to address this feature.

Accordingly, the Applicant respectfully submits that the Office Action has failed to establish a prima facie case of obviousness of Claims 7-8.

With respect to independent Claim 1 (and dependent Claims 2-5), Sharman fails to disclose receiving textual units where each textual unit is one of a word, prefix or suffix, and for each textual unit locating an associated speech sample in memory. It appears that the Office Action understands that Sharman operates on syllables, and such syllables are converted into phonemes. Similarly, Busardo fails to disclose, suggest or teach textual units where each textual unit is one of a word, prefix or suffix. In contrast, Busardo operates on allophones, which are subsets of phonemes. Col. 1, lines 51-58.

Accordingly, the Applicant respectfully submits that the Office Action has failed to establish a prima facie case of obviousness of Claims 1-5 because neither Sharman or Busardo, either alone or in combination, disclose, teach or suggest textual units where each textual unit

is one of a word, prefix or suffix.

With respect to independent Claims 9-12 and 14 (Claim 13 has been canceled), Applicant's remarks and arguments as set forth above with respect to independent Claim 1 also apply to these independent claims.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 1-5, 9-15.

IV. NEW CLAIMS 15-18

New Claims 15-18 have been added. Claims 15-18 depend from Claims 14, 7, 8 and 12, respectively. For the same reasons set forth above, Applicant believes these claims are patentable over the art of record, and respectfully requests allowance of such claims.

V. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

New Claims 15-18 were added as follows:

1 15. The data structure of claim 14 further comprising a field for a phoneme that said
2 textual unit starts with, and a field for a phoneme that the textual unit ends with.

1 16. The method of claim 7 further comprising:
2 passing said marked textual unit to a secondary text to speech engine;
3 receiving a speech sample converted from said marked textual unit from said secondary
4 text to speech engine; and
5 appending said converted speech sample to said output signal.

1 17. The method of claim 8 further comprising:
2 passing said marked textual unit to a secondary text to speech engine;
3 receiving a speech sample converted from said marked textual unit from said secondary text
4 to speech engine; and
5 appending said converted speech sample to said output signal.

1 18. The text to speech conversion system of claim 12 wherein:
2 said pre-processor is further operable to:
3 for each one of said parsed textual units, if said one of said parsed textual units does
4 not correspond to one of said stored textual units, marking said parsed textual unit as being out of
5 vocabulary and add said marked textual unit to said list; and
6 said textual unit processor further comprises:
7 a secondary text to speech engine operable to receive said marked textual unit and
8 convert said marked textual unit into a speech sample.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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